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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,470	10/23/2001	Robert Judge	WELL/003	1041

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EXAMINER

COBANOGLU, DILEK B

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,470

Applicant(s)

JUDGE, ROBERT

Examiner

Dilek B. Cobanoglu

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-43 have been examined.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-12 and 25-43 are rejected under 35 U.S.C. 102(e) as being unpatentable by Stasny (U.S Patent Publication No. 2003/0074234).

A. As per claim 1, Stasny discloses a method for providing a payment analysis pertaining to a prescribed medication purchase over a global set of interconnected computer networks, said method comprising the steps of:

- a) receiving a request to fill a prescribed medication for a user (Stasny; par. 0043 and Fig. 2);
- b) retrieving personal information pertaining to said user from a user profile (Stasny; par. 0044 and 0045); and
- c) correlating said request and said personal information to present at least one alternative medication to said prescribed medication (Stasny; par. 0048 and 0053).

- B. As per claim 2, Stasny discloses the method of claim 1, wherein said retrieving step b) retrieves a benefit design of said user (Stasny; par. 0021).
- C. As per claim 3, Stasny discloses the method of claim 2, wherein said correlating step c) presents said at least one alternative medication and its price as compared to a price of said prescribed medication (Stasny; par. 0053 and 0060).
- D. As per claim 4, Stasny discloses the method of claim 3, wherein said at least one alternative medication is sorted in an order that identifies a least expensive alternative medication as to a copay payable by said user (Stasny; par. 0054 and 0095).
- E. As per claim 5, Stasny discloses the method of claim 4, wherein said at least one alternative medication is further sorted in an order that identifies a least expensive alternative medication as to a cost payable by a benefit provider of said user (Stasny; par. 0054 and 0095).
- F. As per claim 6, Stasny discloses the method of claim 3, wherein said price of said at least one alternative medication is calculated using usual and customary price (Stasny; par. 0053).
- G. As per claim 7, Stasny discloses the method of claim 3, wherein said price of said at least one alternative medication is calculated using average wholesale price (Stasny; par. 0053).

H. As per claim 8, Stasny discloses the method of claim 3, wherein said price of said at least one alternative medication is calculated using maximum allowable cost (Stasny; par. 0054).

I. As per claim 9, Stasny discloses the method of claim 3, wherein said price of said at least one alternative medication is calculated using a third party reimbursed prescription benefit formulary (Stasny; par. 0053 and 0054).

J. As per claim 10, Stasny discloses the method of claim 1, further comprising the step of: d) providing additional information pertaining to said at least one alternative medication to said user (Stasny; par. 0053).

K. As per claim 11, Stasny discloses the method of claim 10, wherein said additional information comprises drug monograph information or product detail page (Stasny; par. 0087).

L. As per claim 12, Stasny discloses the method of claim 1, further comprising the step of: d) forwarding said at least one alternative medication in an email message to a physician specified by said user (Stasny; par. 0052).

M. As per claim 37, Stasny discloses a method for providing a payment analysis pertaining to a prescribed medication purchase over a global set of interconnected computer networks, said method comprising the steps of:

a) receiving a query for a specified medication by a user (Stasny; par. 0051);

b) retrieving a price for said specified medication (Stasny; par. 0052 and 0053); and

c) identifying at least one alternate medication to said specified medication (Stasny; par. 0053);

d) retrieving a price for said at least one alternate medication (Stasny; par. 0053) and

e) displaying a price of said at least one alternate medication and said price for said specified medication (Stasny; par. 0053 and 0054).

N. As per claim 38, Stasny discloses the method of claim 37, wherein said displaying step e) displays both prices simultaneously to said user (Stasny; par. 0053 and 0054).

O. As per claim 39, Stasny discloses the method of claim 38, wherein said price of said at least one alternative medication is calculated using a usual and customary price (Stasny; par. 0053).

P. As per claim 40, Stasny discloses the method of claim 38, wherein said price of said at least one alternative medication is calculated using an average wholesale price (Stasny; par. 0053).

Q. As per claim 41, Stasny discloses the method of claim 38, wherein said price of said at least one alternative medication is calculated using a maximum allowable cost (Stasny; par. 0054).

R. As per claim 42, Stasny discloses the method of claim 38, wherein said price of said at least one alternative medication is calculated using a third party reimbursed prescription benefit formulary (Stasny; par. 0053 and 0054).

- S. As per claim 43, Stasny discloses the method of claim 39, wherein said specified medication is a prescription drug (Stasny; par. 0053).
4. As per claims 25-36, they are apparatus claims, which repeat the same limitations of claims 1-12, the corresponding method claims, as a collection of elements as opposed to a series of process steps. Since the teachings of Stasny (U.S Patent Publication No. 2003/0074234) disclose the underlying process steps that constitute the methods of claims 1-12, it is respectfully submitted that they provide the underlying structural elements that perform the steps as well. As such, the limitations of claims 25-36 are rejected for the same reasons given above for claims 1-12.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stasny (U.S Patent Publication No. 2003/0074234) in view of Wallace et al. (U.S. Patent No. 6,564,121 B1).

Stasny fails to expressly teach a computer-readable medium having stored thereon a plurality of instructions, the plurality of instructions including instructions, which executed by a processor, per se, since it appears that Stasny is more directed to a customer-centered pharmaceutical product and information system wherein the terminals

connected with a network (Stasny; abstract). However, this feature is well known in the art, as evidenced by Wallace et al.

In particular, Wallace et al. discloses a computer-readable medium having stored thereon a plurality of instructions, the plurality of instructions including instructions, which executed by a processor (Wallace et al.; col.41, lines 38-50).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the a customer-centered pharmaceutical product and information system wherein the terminals connected with a network with the computer-readable medium having stored thereon a plurality of instructions, the plurality of instructions including instructions, which executed by a processor with the motivation of components of the dispensing system be physically split and operated from different locations (Wallace et al.; col.41, lines 30-37).

6. As per claims 13-24, it is an article of manufacture claim which repeats the same limitations of claims 1-12, the corresponding method claim, as a collection of executable instructions stored on machine readable media as opposed to a series of process steps. Since the teachings of Stasny (U.S Patent Publication No. 2003/0074234) disclose the underlying process steps that constitute the method of claims 1-12, it is respectfully submitted that they likewise disclose the executable instructions that perform the steps as well. As such, the limitations of claims 13-24 are rejected for the same reasons given above for claims 1-12.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not used prior art teach "Pharmaceutical marketing device and system" 5,799,981 A, "System and method for pricing goods" 2001/0032196, "Method for acquiring and analyzing a list of a patient's prescription medications" 2001/0034613, "System and method for communicating product recall information, product warnings or other product-related information to users of products" 2001/0056359, "System and Method of generating a medication prescription" 2002/0035484, "Computerized prescription system for gathering and presenting information relating to pharmaceuticals" 2002/0042725, "Prescription management system" 2002/0042726, "Method for optimising pharmaceutical prescribing" 2002/0095314, "Method and apparatus for improving patient compliance with prescriptions" 6,587,829 B1, "Health care information system" 6,692,436 B1.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-272-8295. The examiner can normally be reached on 8-4:30.
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3626

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DBC

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Art Unit 3626

02/10/2006


C. LUKE GILLIGAN
PATENT EXAMINER